

**REMARKS**

**I. STATUS OF CLAIMS**

Claims 1-16 are pending. Claims 15-16 are withdrawn from consideration pursuant to 37 C.F.R. § 1.142(b), as allegedly being drawn to a non-elected invention. Claims 9 and 15 have been amended to correct typographical errors. Accordingly, no new matter is added by the amendments provided herein.

**II. REJECTION UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 1-16<sup>1</sup> under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,689,346<sup>2</sup> to Midha et al. ("Midha"). Essentially, the Examiner asserts that one of ordinary skill in the art would have been motivated to use the silicone grafted adhesive polymer disclosed in Midha as a reshaping hair styling composition. See Office Action at page 12. Applicants disagree and traverse the rejection for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143, 8<sup>th</sup> Edition, Rev. 6 (Sept. 2007). In its recent decision in *KSR Internat'l Co. v. Teleflex Inc.*, 550

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<sup>1</sup> Claims 15-16 have been included in this rejection. However, this appears to be a typographical error because the Examiner has indicated on page 2 of the Office Action that claims 15-16 are withdrawn from consideration as relating to non-elected subject matter. Accordingly, claims 15 and 16 are not discussed with respect to this rejection.

<sup>2</sup> The Examiner rejects the claims based on Midha et al. and cites to U.S. Patent No. 6,689,346. It is believed that the Examiner has listed the incorrect patent number in this rejection because Midha et al. are not the inventors of U.S. Patent No. 6,689,346. The inventors of U.S. Patent No. 6,689,346 are Rollat et al. We believe the Examiner intended to refer to U.S. Patent No. 6,555,117, as evidenced by the PTO-892 Form (Notice of References Cited) attached to the Office Action. Accordingly, the remarks submitted herein pertain to U.S. Patent No. 6,555,117.

U.S. \_\_\_, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also *KSR*, 550 U.S. at \_\_\_, 82 U.S.P.Q.2d at 1388.

Indeed, to establish a *prima facie* case of obviousness, the examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. It is important to note that the prior art references relied upon in a rejection "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention," when such reasons are articulated by the

Examiner. *Graham*, 383 U.S. at 17, 148 U.S.P.Q. 467; *See also* M.P.E.P.

§ 2141.03(VI).

The key, moreover, "to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2142. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Applicants respectfully submit that such articulated reasoning is not present in the rejection of record at least because no rationale is set forth why one of ordinary skill in the art would have modified the compositions of Midha to produce a reshaping hair styling composition.

Midha discloses personal care compositions, such as hair compositions. Midha discloses that "[m]any people desire a high level of style retention, or hold, from a hair spray composition." Midha, at col. 1, lines 32 and 33. The object in Midha is to provide hair compositions, such as hair sprays, that can "provide an improved combination of hair hold and hair feel characteristics." *Id.*, at col. 1, lines 38-41. There is absolutely no disclosure in Midha, however, regarding a hair composition having a reshaping effect.

A composition with at least one acrylic copolymer described in the claims may or may not have a reshaping effect. *See* Applicants' specification at page 19, lines 1-7. As explained in the specification, a "reshaping" hair styling composition means a hair styling composition providing a hair styling that can be restored or modified without new material or heat being applied to the hair. *Id.* at page 5, lines 2-8. In particular, a

reshapable hair styling composition permits both (1) the original hair styling to be restored after brushing and (2) the creation of a new hair styling after brushing, which may also be restored after additional brushing. *Id.* at page 18, lines 17-20.

Reshapable hair styling compositions are in sharp contrast to the traditional hair styling compositions of the prior art, such as hair sprays, gels, and mousses, which fix the hair in a single position and do not permit combing or brushing. *Id.* at pages 1-2. Accordingly, Applicants submit that the reshappable property limitation is an appropriate basis to distinguish the claimed polymer over the polymer disclosed in Midha. See *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1435, 7 U.S.P.Q. 2d 1129, 1133 (Fed. Cir. 1988) (noting that “[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”).

The hair care compositions of Midha are the latter kind rather than the former, i.e., they are traditional hair styling compositions that do not permit restyling. In fact, the object in Midha is to provide hair compositions, such as hair sprays, that can provide an improved combination of hair hold and hair feel characteristics, which has nothing to do with reshappable styling. See Midha, col. 1, lines 38-59.

Additionally, the rejection of record fails to establish how one of ordinary skill in the art would have been led to produce such a reshappable effect from the teaching of Midha. In fact, the only statement in the § 103(a) rejection regarding the claimed reshappable effect is found on page 13: “It would have been obvious to one having skill in the art at the time the invention was made to have modified the teaching of Midha et al. for the reshappable hair styling composition.” No rationale is set forth to support the

Examiner's conclusion, and Applicants submit that none can be found in Midha, which is silent with respect to reshaping effect. And the conclusory statement quote above is precisely the type of statement that the prohibited by the Federal Circuit in *In re Kahn* and the Supreme Court in *KSR*. Such conclusory statements can simply not support a rejection on obviousness. Therefore, contrary to the Examiner's bald assertion, it would not have been obvious to simply modify the hair composition in Midha to have a reshaping styling effect and the Examiner has not pointed to any reasoning to show otherwise.

For at least the above reasons, Applicants submit that the Examiner has failed to establish that the claimed invention is *prima facie* obvious based on Midha. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

### III. DOUBLE PATENTING REJECTION

The Examiner has rejected claims 1-16<sup>3</sup> under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-11 of U.S. Patent No. 6,689,346 to Rollat et al.

While Applicants respectfully submit that the present invention is not obvious over claims 1-11 of U.S. Patent No. 6,689,346, to expedite allowance of the present application, Applicants submit herewith a Terminal Disclaimer to obviate the

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obviousness-type double patenting rejection. Accordingly, Applicants respectfully request that the Examiner withdraw the obviousness-type double patenting rejection.

**IV. CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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